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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,908	07/31/2000	Jason A. Kay	3655-0160P	5021
2292	7590	10/03/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			HOFFMANN, JOHN M	
PO BOX 747			ART UNIT	
FALLS CHURCH, VA 22040-0747			PAPER NUMBER	

1731

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/628,908

Applicant(s)

KAY ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 12-16 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-15 and 19-23 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 18 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Oath/Declaration*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Doty 3293018.

Looking to the Doty figures (in particular 1 and 7): 13 and/or 17 is the support device. 15 is the heat source. 28 is the internal mold. The (unnumbered) hand-wheel on feature 14 is deemed to be the "insertion device" - it is deemed that this handwheel is a handle. Feature 23 is the "exterior molding device": looking to the sentence spanning pages 11-12; it is deemed that this device can be a "paddle" and that Doty's 23 is a "paddle". AS to the method of use limitations that indicate as to how the exterior molding device function: the Doty apparatus can be used in such a manner. Although

Doty uses the device to expand the preform outwardly, it could also be used to compress another preform inwardly.

Claim 5: see figure 2, feature 23.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-8, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zauner 4441908 in view of Novini 5095204.

Zauner discloses the invention except for the optical sensing means.

See figures 8 and 10. 46 and/or 16 comprise the support device. 308 are the internal mold and 276 points to one of the outer mold. The paragraph spanning cols. 8-9 discloses that the operation is of the device in the same manner as Applicant claims their invention. Various structure could be considered to be the "insertion device", for example structure 220. It is inherent that there is a heat source.

Optical sensing means are well known; Novini is evidence of this (col.3, lines 14-15). Novini also discloses various advantages throughout the "BACKGROUND ART" section; most notably from col. 2, line 63- col. 3, line 13. It would have been obvious to use a well-known optical sensing mean to check for defects in the Zauner apparatus - for any of the reasons set forth in Novini

Claim 1 is met for substantially the same reason claim 7 is met. As to the language that the insertion device is for inserting the mold "prior to the application of heat". Application of heat is a method of use step which does not have much (if any) bearing on the structure. It is clear that one can apply heat to the tube - well after the final device is made - even if Zauner does not disclose it.

Claim 2 is clearly met.

Claim 3: figure 2, feature 44 is the activation device that sets the internal mold as claimed - via the camming action of features 212 and 224 (fig. 8).

Claim 4 is clearly met.

Claim 6, feature 274 is the holding device.

Claims 7-8 and 16 are clearly met.

#### ***Allowable Subject Matter***

Claims 12-15 and 19-23 are allowed.

#### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

It is argued that the rejection of claim 5 is improper since it is based on non-existent language. That part of the rejection was merely an "alternative" interpretation. To remove issues, this portion of the rejection is no longer maintained.

It is further argued that Doty does not disclose the combination, and then a large portion of claim 5 is reproduced on page 16 of the response of 18 July 2003. However

there doesn't appear to be any indication what specific part of the combination is missing.

However, it is further argued that one of ordinary skill would not interpret the paddle of Doty to read on the claim invention. No rationale or evidence is used to support this. So, Examiner cannot agree an argument based only on assertion. It is noted that claims are not interpreted in a vacuum. As indicated in the rejection, the claim is interpreted based on the specification. Since Applicant's invention reads on a paddle, any art that also has a paddle should also read on the claim.

Regarding the combination of Zauner and Novini, it is argued that the Office has not provided any reason as to why an artisan would include the optical sensor "within" the device used for shaping. This is not persuasive because the claims do not require that the optical sensing device be "within" the same equipment used to shape and form the tube. Therefore the Office need not demonstrate any reason for using a sensor within the shaping device.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

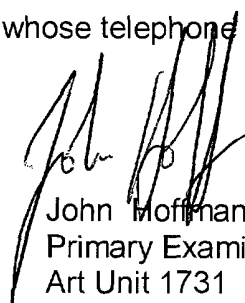
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is 703-308-0469. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-372-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

  
John Hoffmann  
Primary Examiner  
Art Unit 1731  
9-30-03

jmh  
September 30, 2003